

REMARKS

Applicants submit this Amendment in response to a non-final Office Action mailed on October 4, 2004. Applicants make this Amendment without prejudice or disclaimer. Claims 1-20 are pending in the Application. In making this Amendment, Applicants have added no new matter. Support for the amendments above can be found in the specification and claims as filed. Reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and the following remarks.

The Office Action objects to the title of the invention as not descriptive. Applicants respectfully assert that the original title is descriptive; however, Applicants have amended the title to advance prosecution of the present application.

The Office Action rejects claims 1-5 and 9-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,295,513 to Thackston (hereinafter “Thackston”). The Office Action rejects claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Thackston.

A. Claims 1-5 and 9-20

Claims 1-5 and 9-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Thackston. The rejection under 35 U.S.C. § 102(b) is improper because Thackston was patented less than one year prior to the date of the present application. Thackston was patented on September 25, 2001, five months prior to the date of the present application (February 25, 2002).

Notwithstanding the improper rejection under 35 U.S.C. § 102(b), Thackston does not anticipate the present application because Thackston does not disclose each and every element of the claims at issue. A claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *See* MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987)).

For example, as amended, independent claim 1 claims a method, which includes, among other elements, “identifying an optimal machine and tooling combination for production of said part.” Claims 2-5 and 9-20 depend ultimately from independent claim 1. Thackston does not disclose a method that includes “identifying an optimal machine and tooling combination for production of said part,” as claimed.

Thackston does not describe, or even contemplate, production or manufacture, let alone identifying an optimal machine and tooling combination for production of a part. Thus, Thackston does not disclose “identifying an optimal machine and tooling combination for production of said part.”

As Thackston does not disclose each and every element of independent claim 1, Applicants respectfully submit that independent claim 1 is patentable over Thackston. Claims 2-5 and 9-20 depend ultimately from independent claim 1, and are, therefore, also allowable for at least the same reasons as independent claim 1.

Accordingly, the rejections to claims 1-5 and 9-20 should be withdrawn and the claims allowed.

C. **Claims 6-8**

Claims 6-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Thackston. Claims 6-8 depend ultimately from independent claim 1. The rejection under 35 U.S.C. § 103(a) is improper because Thackston does not teach or suggest all the claim elements of claims 6-8. One of the criteria for a *prima facie* case of obviousness is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2143.

As discussed above, Thackston does not teach or suggest all the claim elements of independent claim 1. Dependent claims include all of the elements of the claim from which they depend. Thus, claims 6-8 are therefore also allowable for at least the same reasons as independent claim 1. Accordingly, the rejections to claims 6-8 should be withdrawn and the claims allowed.

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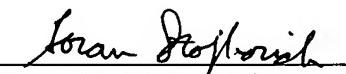
CONCLUSION

Applicants respectfully submit that the pending claims are allowable.

Applicants respectfully solicit the issuance of a timely Notice of Allowance for all pending claims. The Examiner is invited to contact the undersigned by telephone to discuss any matter related to the Application.

Respectfully submitted,

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